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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,552	10/06/2003	Robert Beson	9764-19US (12828/GW)	4165
570	7590	06/03/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			BARRERA, RAMON M	
			ART UNIT	PAPER NUMBER
			2832	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/680,552

Applicant(s)

BESON, ROBERT

Examiner

Ramon M. Barrera

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 and 87-117 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-68 87-117 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-31, 60, 61, 104-111 drawn to a magnetic holding device.

Group II, claim(s) 32-47, drawn to a method of manufacturing the magnetic holding device

Group III, claim(s) 48-59, 62-68, 87-94, drawn to a metal conductor.

Group IV, claim(s) 95-103, 112-117, drawn to a method for aligning a die.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 lacks the "at least one bore" recited in Claims 32 and 33.

3. The inventions listed as Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 1 is directed to a magnetic holding device. It is considered that the insulating means made of nonmagnetic material imposed between said region and said support structure to resist magnetic induction of, or leakage to, said support structure comprises a first "special technical feature".

Claims 48, 53, and 62 are directed to a metal conductor. It is considered that the second region made of a relatively good thermal and electrical conducting metal surrounding the first region from the support structure, whereby the rate of thermal and

Art Unit: 2832

electrical conductivity of the metal conductor as a whole is better than the rate of the thermal or electrical conductivity of the second region material alone comprises a second "special technical feature".

4. The inventions listed as Groups I and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 95 lacks the structure of the magnetic holding device recited in Claim 1.

5. In Group I, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- A.
 - 1. magnetic region includes a magnetisable core subject to an electric field
 - 2. magnetic region is in the form of a permanent magnet 8
- B.
 - 1. the bore in which the magnetic region resides is in the shape of a cup (Fig. 4)
 - 2. the bore in which the magnetic region resides is in the shape of a channel (Fig. 3)
 - 3. the bore in which the magnetic region resides is in the shape of a block (Fig. 5)

Art Unit: 2832

- C.
 - 1. the plurality of magnetic regions is orientated so that the north poles are co-planar
 - 2. the magnetic regions are grouped so that members within each group share the same pole in a common plane but have opposite poles to each adjacent group
 - 3. adjacent magnetic regions have opposite poles

- D.
 - 1. the magnetic regions include a magnetic surface which lies close to or flush with the planar bearing surface
 - 2. the magnetic surface lies flush with the planar bearing surface
 - 3. the magnetic surface lies just beneath the plane of the planar bearing surface

- E. The insulating means is:
 - 1. polymeric material which includes a thermoset resin selected from the group including:
 - a. allyl polymers,
 - b. epoxy polymers,
 - c. furan,
 - d. melamine formaldehyde
 - e. phenolic polymers

Art Unit: 2832

- f. polybutyldiene polymers,
- g. thermoset polyester and alkyd polymers,
- h. thermoset polyamide polymers,
- i. thermoset polyurethane polymers,
- j. flexible thermoset silicone polymers
- k. silicone epoxy polymers and
- l. thermoset urea polymers.

2. Cu alloy

F. The bearing surface is in the form of a

- 1. planar,
- 2. cylindrical or otherwise curved surface

If Group I is elected, Applicant is required, in reply to this action, to elect a single species from each of Groups A-F to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. The claims are deemed to correspond to the species listed above in the following manner:

A. 8

B. 1. 13, 14, 28

2. 14,28

3. 13,14

C. 1. 18

2. 19

3. 20

D. 1. 22

2. 23

3. 24

E. 1. 26

2. 27

F. 1. 2-5, 61

2. 61

The following claim(s) are generic: 1, 6, 7, 9-12, 15-17, 21, 25, 29, 30-31, 60.


7. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the species comprise structural, magnetic, and chemical differences.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramon M. Barrera whose telephone number is (571) 272-1987. The examiner can normally be reached on Monday through Friday from 11 to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ramon M Barrera
Primary Examiner
Art Unit 2832

rmb